

Application No. 10/630,883
Amendment dated January 24, 2011
Reply to Office Action of August 23, 2010

REMARKS

**Reconsideration And Allowance
Are Respectfully Requested.**

Claims 53-63 are currently pending. No claims have been amended. Claims 1-52 were previously canceled. No new matter has been added. No new claims have been added. Reconsideration is respectfully requested.

NEW OATH/DECLARATION REQUIREMENT

The requirement for a new or supplemental oath or declaration is deemed improper as the subject matter of the claims is clearly set forth in the parent application SN 08/308,097 from which the current application claims priority. The current claims may not quote the parent specification verbatim, nor do the pending claims include the “cavity site” language noted by the Examiner, but surely one of ordinary skill in the art would understand that “the creation of a cavity site from which a tissue sample has been removed during a biopsy” is inherent in the disclosure. The definition of the term “biopsy” in and of itself indicates that tissue has been removed and if tissue is removed what remains is a cavity where the tissue previously resided. The parent specification discloses removing tissue and marking the location.

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Regardless, the claims were previously amended (see Amendment, June 16, 2010) to use the broader term “location”, which is the exact language used in the specification. The term “location” would include any cavity formed by the removal of tissue. Accordingly, the request for a supplemental oath/declaration is considered moot.

Specific support can be found in the specification as originally filed on page 3, lines 1-3, page 7, lines 4-8, page 19, line 25 and page 23, line 4. The specification at page 3, lines 1-3, states “...mark the location or margins of such a lesion prior to or immediately after removing or sampling tissue”. The specification at page 7, lines 4-8, states “...a biopsy needle or gun, such as is often used to extract tissue for examination in a biopsy procedure, is used in conjunction with the marking device...”. The specification at page 19, line 25 and page 23, line 4 both use the term biopsy site(s) which as discussed previously inherently indicates the location from which the tissue to be tested has been removed.

112 REJECTIONS

With regard to the rejections of claim 53 and claims 54-57 under 35 U.S.C. 112, first paragraph, these rejections are deemed moot in view of the previous amendment to the claims. The terms relating to the “biopsy cavity” have been removed and terminology directed to location and removal are positively recited in the specification as originally filed. As discussed previously, the language regarding a cavity is inherent and removing of tissue is

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disclosed in the specification as originally filed. The creation of a cavity is also inherent in the term biopsy.

Further, and with regard to claims 54, 56, 57, 62 and 63, the specification on page 9, lines 14-19 supports these claims. The language reads, "The marker element, which is preferably comprised of a biocompatible, implantable, and substantially radiopaque material...". This language indicates that the marker element could contain radiopaque material and does not foreclose that other materials such as ultrasonically detectable materials could be contained in the marker element.

103 REJECTION

Claims 58-63 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over U.S. Patent No. 6,161,034 to Burbank et al. ("Burbank") in view of U.S. Patent No. 5,545,208 to Wolff et al. ("Wolff"). Applicants consider this rejection to be improper and respectfully request it be withdrawn.

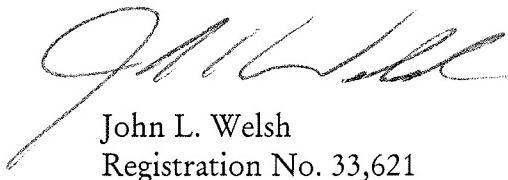
As previously indicated in a prior amendment, Burbank does not constitute prior art. Burbank does not have a priority date prior to September 16, 1994 (the filing date of Serial No. 08/308,097), to which Applicants' claims are entitled.

It has now been shown the § 103 rejection is improper and it is respectfully requested that the rejection of claims 53-63 be withdrawn.

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If it is felt that an interview would expedite prosecution of this application, please do not hesitate to contact Applicants' representative at the below number.

Respectfully submitted,



The image shows a handwritten signature in black ink, appearing to read "John L. Welsh".

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